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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,144	03/29/2001	Jin-Yong Joo	122990-05163098	3413

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MAYER, BROWN, ROWE & MAW LLP  
1909 K STREET, N.W.  
WASHINGTON, DC 20006

EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/763,144

Applicant(s)

JOO, JIN-YONG

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 4 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/19/06 and 12/4/06.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 3 and 4 are system (apparatus) claims, yet they include many features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to set forth *capabilities* of the device by stating an element is *programmed to <perform an act>* rather than stating the item performs the act. In this case, the language such as "detects", "displays", "controls", etc should be corrected to state that the browser is programmed to detect and the program is capable of detecting, etc.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 3, 4, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US6302162) in view of Harding (US6307544) and Hoyle (US6628314).**

Burke teaches a client application that communicates with the Internet as a web browser [5:64-67, 7:33-38]. The user interface includes a web page display area 530 (text box) and screen areas 540 and 550 located above and below the text/web content box 530 [fig 5]. Burke teaches that the screen areas 540 and 550 are used for displaying advertisements and for displaying menu icons as a graphical user interface (GUI) to the browser software functions, such as those functions available within Netscape or IE [8:26-34]. While Burke teaches ads and menus in these screen regions, Burke does not teach dynamic display of them based upon the user's mousing properties. Harding teaches a GUI for a software application whereby when a user's mouse hovers over a particular area of the interface, menus dynamically appear in order to launch other applications or applets (i.e. program functionality) from them [3:10-21, 55-67, 4:1-5]. When the mouse leaves this toolbar region, the dynamically appearing menus disappear. It would have been obvious to one of ordinary skill at the time of the invention to have provided Burke's advertising content in the suggested screen areas and dynamically changed such screen regions to popup menus for further browser functionality when a user hovers the mouse in the area in order to provide an easy to user graphical user interface. Similarly, such dynamic menus would disappear when the user's mouse leaves the area, leaving the advertising to re-appear. Burke does not appear to teach where the advertising comes from. Hoyle also teaches a

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browser application that includes a built-in advertising display area. The ads of Hoyle are periodically downloaded from an advertising server when requested by the client application and then subsequently displayed in the ad area [19:1-4]. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded ads to the client software of Burke periodically so that different, newer ads can be shown to the user.

**4. Claims 3, 4, 8 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US6302162) in view of Nicholas III (US6865719).**

5. Burke teaches a client application that communicates with the Internet as a web browser [5:64-67, 7:33-38]. The user interface includes a web page display area 530 (text box) and screen areas 540 and 550 located above and below the text/web content box 530 [fig 5]. Burke teaches that the screen areas 540 and 550 are used for displaying advertisements and for displaying menu icons as a graphical user interface (GUI) to the browser software functions, such as those functions available within Netscape or IE [8:26-34]. While Burke teaches ads and menus in these screen regions, Burke does not teach dynamic display of them based upon the user's mousing properties. Nicholas III teaches a browser programmed to dynamically display advertising to a web surfing user depending on the user's mousing actions. While Nicholas III teaches that ad content is displayed which follows the user's mouse positions [fig 2A, col 5 line 66 to col 6 line 2]. The entirety of Nicholas III stresses that the advertising is not to distract the user or prevent him from accessing important areas of the screen. In particular, the advertising disappears when the user moves his mouse

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into certain areas of the screen [col 3 lines 13-19]. For example when a user moves the mouse cursor over a link, the advertising disappears [col 6 lines 8-11]. It would have been obvious to one of ordinary skill at the time of the invention to have provided this approach to the combined advertising and menubar area of Burke so that advertising can be displayed on the toolbar when the mouse is in an area where the advertising will not overly disturb the user or prevent the user from using the menu, yet cause the advertising to disappear when the user moves the mouse cursor into areas that will disturb the user such as when mousing into the browser's toolbar. Further, it is noted that Nicholas III's (and most if not all) browser toolbar area includes a field for entering web addresses. Nicholas III clearly states that advertising that is otherwise displayed will disappear when a user positions the cursor over a typing field [col 7 lines 40-43], which would have been obvious to do with the combined advertising/GUI toolbar of Burke.

### ***Response to Arguments***

6. Applicant argues that Burke fails to teach replacing a displayed ad with a menu icon. Examiner agrees and relies on the addition of Harding who teaches dynamically displayed elements to provide evidence as a whole that would have suggested the proposed rejection to one of ordinary skill.

7. Applicant argues that the motivation of providing an easy(ier) interface is contrary to examiner's position. Examiner believes that revealing details of menu functionality only when a user needs them upon mousing over an area, provides an easier user interface than if one merely presents every menu functionality at the same time.

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Harding's ease of use stems from the dynamically appearing menu complexity; one of ordinary skill would recognize the ease-of-use benefits of Harding's dynamic menus.

8. Burke teaches the desire for ads and menus in the same screen region. Harding teaches dynamically displaying and as well as dynamically disappearing program functionality items depending on the mouse location. Examiner believes it to be obvious to provide menus that appear when the mouse arrives and ads that appear (menus disappear) when the mouse leaves.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc